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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,962	10/15/2003	Leonid Matsiev	1012.122C4	7944
25215	7590	12/28/2004	EXAMINER	
DOBRUSIN & THENNISCH PC 29 W LAWRENCE ST SUITE 210 PONTIAC, MI 48342			MILLER, ROSE MARY	
			ART UNIT	PAPER NUMBER
			2856	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/685,962

Applicant(s)

MATSIEV ET AL.

Examiner

Rose M Miller

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-13 and 15 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6, 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 5, 7, 8 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

Specification

1. The specification filed 15 October 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure (as filed in Parent Application 10/266,047) is as follows: Figures 1-2, 4, 7, 8, 10 and 11, all subject matter in the specification pertaining to the Figures, and all subject matter which was not disclosed in Parent Application 10/266,047.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The above objection arises from Applicant's attempt to re-introduce subject matter disclosed in Original filed Application 08/946,921 but which was dropped from prosecution with the filing of CIP Application 09/133,171. It is clear from the multiple applications claiming Priority to Application 09/133,171 that the subject matter not included in 09/133,171 was not "inadvertently" dropped. Such "inadvertent" dropping would have allowed for the re-insertion of such subject matter. However, as it is clear this subject matter was deliberately dropped instead of "inadvertently" dropped, the subject matter cannot be added at this time if the present Application is to maintain its status as a Continuation of 10/266,047.

The MPEP § 201.07 is clear on the definition of a Continuation Application. The Disclosure must be the same as that of the original application and should not include anything that would constitute new matter if inserted in the original application.

201.07 [R-2] Continuation Application

A continuation is a second application for the same invention claimed in a prior nonprovisional application and filed before the original prior application becomes abandoned or patented. The continuation application may be filed under 37 CFR 1.53(b) >(or 1.53(d) >if the application is a design application)<. The applicant in the continuation application must include at least one inventor named in the prior

nonprovisional application. The disclosure presented in the continuation must be the same as that of the original application; i.e., the continuation should not include anything which would constitute new matter if inserted in the original application. The continuation application must claim the benefit of the prior nonprovisional application under 35 U.S.C. 120 or 365(c).

The MPEP provides clear guidelines on the filing of a Continuation or Divisional Application with the following:

SPECIFICATION AND DRAWINGS

A continuation or divisional application may be filed under 35 U.S.C. 111(a) using the procedures set forth in 37 CFR 1.53(b), by providing: (A) a copy of the prior application, including a copy of the signed oath or declaration in such prior application, as filed; (B) a new specification and drawings and a copy of the signed oath or declaration as filed in the prior application provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application; or (C) a new specification and drawings and a newly executed oath or declaration provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. If a continuation or divisional application filed with a newly executed oath or declaration contains subject matter that would have been new matter in the prior application, the application will have to be amended to indicate that it is a continuation-in-part application rather than a continuation or a divisional application. The specification and drawings of a continuation or divisional application filed under 37 CFR 1.53(b) are not limited to a reproduction or "true copy" of the prior application, i.e., the applicant may revise the specification for clarity or contextual purposes vis-à-vis the specification originally filed in the prior application in the manner that an applicant may file a substitute specification, see 37 CFR 1.125, or amend the drawings of an application so long as it does not result in the introduction of new matter. It is the applicant's responsibility to review any new specification or drawings submitted for a continuation or divisional application under 37

CFR 1.53(b) and 37 CFR 1.63(d) to determine that it contains no new matter. An applicant is advised to simply file a continuing application with a newly executed oath or declaration when it is questionable as to whether the continuing application adds material that would have been new matter if presented in the prior application. If one or more claims are allowed in the continuation or divisional application which are directed to matter shown and described in the prior nonprovisional application but not claimed in the prior application, the applicant should be required to file a supplemental oath or declaration under 37 CFR 1.67(b).

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This includes the referencing of other Application within the Specification. All references to Applications before the office should be updated to reflect the current status of the Application cited.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2 and 9-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Originally filed Specification, both as filed on 15 October 2003 with the present Application, in the Specification filed in Parent Application 10/266,047, or in the

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original parent 08/946,921 (of which parent 09/800,819 is a divisional of 09/133,171 which is a CIP of 08/946,921), fails to provide sufficient support for the specific measurement of density, or any combination which measures said property.

The Originally filed Specification, both as filed on 15 October 2003 with the present Application and in the Specification filed in Parent Application 10/266,047, fails to provide sufficient support for the specific measurement of elasticity, or any combination which measures said property.

Claims 9-10 are rejected as they fail to correct the problems presented by Claim 2 from which they depend.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-2, 4, and 6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-12 of U.S. Patent No. 6,494,079 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a variable frequency input signal to oscillate the tuning fork resonator would have been obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

8. Applicant's arguments filed 20 September 2004 have been fully considered but they are not persuasive.

With regards to Applicant's arguments on pages 6-10 of the remarks about the priority to previously filed Applications, these arguments are not persuasive. The Examiner is not questioning the string of Applications which have preceded the present Application. However, Applicant clearly rewrote the specification which was filed in CIP Parent Application 09/133,171 and did not specifically include all of the subject matter of the previously filed Application 08/946,921. The Examiner is not questioning or arguing the statement at the beginning of the specification of 09/133,171 which referenced the parent application. However, as Parent Application 08/946,921 was neither a US Patent nor an allowed US Application, as is required for the incorporation of **essential** subject matter, at the time of the filing (08/946,921 was not allowed by the office until over 2 years after 09/133,171 was filed), the Examiner can only conclude that Parent Application 08/946,921 was only being relied upon for inadvertently omitted subject matter and **nonessential** subject matter. Therefore, the inclusion of the subject matter dropped in the re-writing of the specification for filing as CIP Application 09/133,171 in the present application can only be considered a new matter issue and is clearly an attempt by Applicant to recover subject matter which was not considered to be essential subject matter at the time of the filing of CIP Parent 09/133,171.

Furthermore, Parent Application 08/946,921 itself referred to its Parent application 08/898,715, which it incorporated by reference (Application 08/946,921 was a CIP of 08/898,715). If one of ordinary skill in the art was to conclude that Parent Application 08/946,921 itself incorporated essential subject matter by reference (by referring to a parent application, which is the basis of Applicant's arguments), then the incorporation of 08/946,921 into any of the applications for the purposes of documenting essential subject matter not specifically and fully disclosed is improper as essential subject matter cannot be incorporated from a reference which itself incorporates essential subject matter.

Therefore, the objection to the specification as containing New Matter stands and is hereby made final.

Applicant's arguments with regards to the Rejections of Claims 2-5, 7, 9, 10, and 12 under 35 U.S.C. §112, first paragraph (as found on page 10 of Applicant's Remarks) are partially persuasive in view of Applicant's amendment to the claims. Claims 2 and 9-10 remain rejected under 35 U.S.C. §112, first paragraph. The originally filed specification, including any of the originally filed specifications in the numerous parent applications, fail to measure or indicate the measurement of density. Furthermore, the only measurement of elasticity that can be found is in original application 08/946,921 and it was not carried forward into CIP Parent Application 09/133,171. Therefore, the measurement of density or elasticity is considered to be new matter and must be removed from the claim as CIP Parent Application 09/133,171 (and all subsequent application filings) did not provide sufficient support for the claimed subjected matter as is now found in the present application.

With regards to Applicant's response to the Obviousness-type Double Patenting found on page 11 of Applicant's Remarks, no Terminal Disclaimer has been received by the office. Therefore, the Obviousness-type Double Patenting rejections remain and have been made final.

With regards to Applicant's response to the Rejections of Claims 1 and 11 under art as found on page 11, these arguments are moot as these rejections have been withdrawn in view of Applicant's amendments to the claims. Bonne does not teach the measurement of an electrical property of the fluid under test.

Allowable Subject Matter

9. Claims 5, 7-8, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 11-13 and 15 are allowed.

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Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rose M Miller whose telephone number is 571-272-2199. The examiner can normally be reached on Monday - Thursday, 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RMM
3 May 2004


HEZRON WILLIAMS
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